

PATENT
Attorney Docket No. 231461
Client Reference No. E-262-2000/1-US-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

BURKE, Jr. et al.

Application No. 10/517,717

Filed: December 10, 2004

For: SH2 DOMAIN BINDING INHIBITORS

Art Unit: Unassigned

Examiner: Unassigned

Mail Stop PCT
Commissioner for Patents
Attention: Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 CFR § 1.497(d)

This is in response to the Decision on Request under 37 CFR § 1.497(d) dated February 17, 2005 ("the Decision"). Applicants' Request to Correct Inventorship under 37 CFR § 1.48 filed on December 10, 2004 stands dismissed without prejudice. The Decision sets forth a two-month time limit for filing a request for reconsideration. A copy of the Decision is attached.

By way of background, Applicants forwarded to the PTO on December 10, 2004 a transmittal letter for entry into the U.S. national phase of PCT/US2003/019987, along with a Preliminary Amendment, Amendment of Inventorship, Request to Correct Inventorship under 37 CFR § 1.48, an Information Disclosure Statement, and an Application Data Sheet. Applicants also paid the required fee for national phase entry. The Request to Correct Inventorship was filed to delete one of the originally named PCT inventors since the deleted inventor's invention is no longer being claimed in the national phase (see Preliminary Amendment). The Request to Correct Inventorship filed under 37 CFR § 1.148(b) has been treated as a request under 37 CFR § 1.497(d).

On January 26, 2005, Applicants forwarded another transmittal letter, along with a Combined Declaration and Power of Attorney ("Declaration 1") and a Supplemental Application Data Sheet. Declaration 1 did not include the name of the deleted inventor.

In re Appln. of BURKE, Jr. et al
Application No. 10/517,717

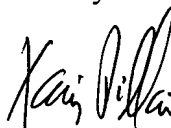
Applicants wish to thank Attorney Advisor Derek A. Putonen of the Office of PCT Legal Administration for the courtesies extended to Xavier Pillai, one of the Applicants' attorneys, during the telephone conversation held on March 2, 2005 to discuss the Decision. The Attorney Advisor indicated that a declaration referring to the PCT Application (PCT/US2003/019987) should be filed with signatures from all the inventors named on the PCT application to meet the requirement under 35 USC § 371(c)(4) and that this should satisfy the requirement for initial examination of the application. The Attorney Advisor also indicated that a statement from the deleted inventor is not required.

Accordingly, Applicants now enclose a Combined Declaration for Utility or Design patent Application and Power of Attorney, referring to the PCT application and signed by all five originally named inventors of the PCT application ("Declaration 2").

In view of the foregoing, Applicants respectfully request reconsideration. Applicants respectfully submit that there has been no error in naming the PCT inventors as originally filed. Accordingly, it is not necessary to submit a statement from the deleted inventor. In addition, Applicants respectfully submit that a consent of existing assignee is not required to be submitted.

Applicants respectfully submit that the Applicants have fulfilled all the requirements for entry into the national phase. Applicants also respectfully request that the inventorship be amended as requested.


Respectfully submitted,



Xavier Pillai, Reg. No. 39,799
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: March 17, 2005

In re Appln. of BURKE, Jr. et al
Application No. 10/517,717

<i>CERTIFICATE OF MAILING UNDER 37 CFR 1.10</i>			
I hereby certify that this Response to Office Action and all accompanying documents are being deposited with the United States Postal Service on March 17, 2005, in an envelope as "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10, Mailing Label Number EV 336873520 US, addressed to: Mail Stop PCT, Commissioner for Patents, Attn: Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450.			
<i>Name (Print/Type)</i>	Xavier Pillai		
<i>Signature</i>		<i>Date</i>	March 17, 2005

M:\clients\NIH\Petitions\231461 Renewed Petition (3-16-05).doc

COMBINED DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION
AND POWER OF ATTORNEY

- ☐ Declaration Submitted with Initial Filing OR
☒ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16(e)) required)

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name. I believe I am the original, first, and sole inventor (*if only one name is listed below*) or an original, first, and joint inventor (*if plural names are listed below*) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

SH2 DOMAIN BINDING INHIBITORS

the specification of which:

- ☐ is attached hereto.
☐ was filed on _____ as Application No. _____ and was amended on _____ (*if applicable*).
☐ was filed by Express Mail No. _____ as Application No. *not known yet*, and was amended on _____ (*if applicable*).
☒ was filed on June 26, 2003 as PCT International Application No. PCT/US2003/019987 and was amended on _____ (*if any*).

I state that I have reviewed and understand the contents of the specification identified above, including the claim(s), as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I claim foreign priority benefits under 35 USC 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application(s) designating at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application(s) for patent, utility model, design registration, inventor's or plant breeder's rights certificate(s), or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter and having a filing date before that of the application(s) from which the benefit of priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Claimed		Certified Copy Attached?	
			YES	NO	YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

In re Appln. of Burke et al.
Attorney Docket No. 231461

As a named inventor, I hereby appoint the attorneys and patent agents of the National Institutes of Health, Office of Technology Transfer, and of Leydig, Voit & Mayer, Ltd., who are identified with the following Customer Number, to prosecute this application and transact all business in the U.S. Patent and Trademark Office connected therewith:

45733

I further direct that correspondence concerning this application be directed to Leydig, Voit & Mayer, Ltd., as Customer Number:

45733

I declare that all statements made herein of my own knowledge are true, that all statements made on information and belief are believed to be true, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor: Terrence R. Burke, Jr.

Inventor's signature Terrence R. Burke, Jr.

Date 3/9/2005


Country of Citizenship: US

Residence: Bethesda, MD
(city/state or country)

Post Office Address: 7400 Lakeview Drive, Bethesda, MD 20817
(complete mailing address)

In re Appln. of Burke et al.
Attorney Docket No. 231461

Full name of second joint inventor, if any: Chang-Qing Wei

Inventor's signature  Wei

Date March 9, 2005

Country of Citizenship: China

Residence: Ottawa, Canada
(city/state or country)

Post Office Address: 290 Nelson Street, Apt. 5404, Ottawa, Ontario, Canada K1N 7S3
(complete mailing address)

In re Appln. of Burke et al.
Attorney Docket No. 231461

Full name of **third joint inventor**, if any: Johannes H. Voigt

Inventor's signature Johannes H. Voigt

Date March 9, 2005

Country of Citizenship: Germany

Residence: Cranford, NJ
(city/state or country)

Post Office Address: 10 Willow St, Cranford, NJ 07016
(complete mailing address)

In re Appln. of Burke et al.
Attorney Docket No. 231461

Full name of fourth joint inventor, if any: Zhen-Dan Shi

Inventor's signature Zhen-Dan Shi

Date 3/9/2005

Country of Citizenship: Chinese

Residence: Frederick, MD
(city/state or country)

Post Office Address: 1415 Key Parkway, Apt. B5, Frederick, MD 21702
(complete mailing address)

In re Appln. of Burke et al.
Attorney Docket No. 231461

Full name of fifth joint inventor, if any: Yang Gao

Inventor's signature

Date 03/08/2005

Country of Citizenship: China

Residence: Madison, CT
(city/state or country)

Post Office Address: 524 Opening Hill Road, Madison, CT 06443
(complete mailing address)